



PATENT
Customer No. 22,852
Attorney Docket No. 02860.0705

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Takumi MATSUI) Group Art Unit: 2655
Application No.: 10/086,547) Examiner: Guatam Patel
Filed: March 4, 2002)
For: OPTICAL PICK-UP APPARATUS,)
LIGHT CONVERGING OPTICAL)
SYSTEM OF OPTICAL PICK-UP)
APPARATUS, AND OPTICAL)
INFORMATION RECORDING AND)
REPRODUCING METHOD)

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Sir:

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

In an election of species requirement dated April 13, 2004, the Examiner required election under 35 U.S.C. § 121 of one patentably distinct species from among Figures 2-9. In addition, the Examiner required a further selection among Figures 1 and 10 that “is usable among any one of [Figures 2-9].”

In response to the mandatory election of species requirement, Applicant elects, with traverse, to prosecute the subject matter of Figure 2 of Figures 2-9 and further elects, with traverse, to prosecute the subject matter of Figure 1 of Figures 1 and 10.

The Examiner further required Applicant to identify all claims that “read on” the elected species and any generic claims. The Examiner indicated that no claims are

considered generic. Applicant asserts that at least claims 1, 3-6, 8-18, 20-30, 32, 34-44, 46-55, 57-72, 74-98, 100-109, and 111-162 "read on" the species elected. In addition, Applicant asserts that, despite the Examiner's comments to the contrary, at least claims 1, 29, 55, 83, 109, and 137 are generic. Upon allowance of any of these generic claims, Applicant understands that any nonelected claim depending from these claims or otherwise containing all the recitations in these claims will be rejoined and also allowed.

Applicant reminds the Examiner of the criteria and guidelines set forth in M.P.E.P. 803. In particular, the Examiner has failed to provide the required reasons and/or examples to support his conclusions. Without this, Applicant cannot understand the reasons for this restriction/election of species. In view of the assertion that Figures 2 to 9 contain patentably distinct species, Applicant believes the Examiner does not fully understand what the different figures illustrate. Accordingly, Applicant offers the following reasons to support the traverse of this particular requirement for an election of species.

Regarding Figs. 2-9, Fig. 2 illustrates an embodiment of a whole optical pick-up apparatus, while Figs. 3-9 illustrate embodiments of a part or parts of the optical pick-up apparatus. In other words, Figs. 3-9 illustrate certain parts of what Fig. 2 illustrates. In addition, Fig. 1 illustrates a fundamental principle of the near field effect according to certain embodiments of the invention, while Fig. 10 illustrates an embodiment utilizing this fundamental principle. As such, it is difficult for Applicant to discern the reasons under which the Examiner required restriction/election of species. Accordingly Applicant solicits withdrawal of the restriction/election of species.

Applicant additionally traverses the Election of Species Requirement because the Examiner has not shown that there would be a serious burden to examine all of the pending claims together. M.P.E.P. 803. Indeed, the Examiner has failed to even state that any such burden exists. Accordingly, Applicant respectfully submits that the Election of Species Requirement is improper and requests that it be withdrawn.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 13, 2004

By:


Michael Kelly
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